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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,814	06/09/2000	Nori Yoshihara	10089/11	3180
26646	7590	01/05/2004		
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			EXAMINER CHEUNG, WILLIAM K	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 01/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/590,814

Applicant(s)

YOSHIHARA ET AL.

Examiner

William K Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1, 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal (US 3,769,260) in view of Yoshihara et al. (US 5,399,605).

*The invention of claims 1, 3 relates to a polyester resin composition for engine peripheral parts, the resin composition comprising:*

(A) **60-92% by weight of at least one polymer selected from the group consisting of polyethylene terephthalate and an thylene terephthalate copolymer;**

(B) **5-15% by weight of talc; and**

(C) **3-25% by weight of an olefin polymer,**

**wherein a molded article produced from the resin composition has a flexural strain at break of 3.5% or higher and a deflection temperature under load of 180°C or higher.**

Segal (col. 10, claims 1-3) discloses a polyesters resin composition comprising 25 to 95 percent of polyethylene terephthalate, 0.5 to 30 percent of polyolefin, and 2 to 70 percent of inorganic reinforcement.

The difference between the invention of claims 1, 3 and the disclosure to Segal is that Segal is silent on a composition comprising a 5-15% by weight of talc.

Yoshihara et al. (col. 5-6, Table 1-2) disclose compositions comprising polyethylene terephthalate with talc. Further, Yoshihara et al. (col. 4, line 30-34) disclose that 0.5 to 20 parts by weight of talc, per 100 parts by-weight of the total weight of the polyester resin could be used. Motivated by the expectation of success of reducing post-shrinkages (col. 6, line 22-29), it would have been obvious to one of ordinary skill in art to incorporate 0.5 to 20 parts by weight of talc into the composition of Segal to obtain the invention of claims 1, 3. Although the claimed range of talc is narrower as compared to the disclosed range of 0.5 to 20 parts, however, applicants

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must recognize that the claimed weight% range is entirely covered by the amount of talc taught by Yoshihara et al.

3. Claims 2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal (US 3,769,260).

*The invention of claims 2, 4 relates to a **polyesters resin composition** for engine peripheral parts, the resin composition comprising:*

*(A) **100 parts** by weight of at least one polymer selected from the group consisting of **polyethylene terephthalate** and an **ethylene terephthalate copolymer**;*

*(B) **5-70 parts** by weight of an **inorganic reinforcement material**;*

*(C) **2-20 parts** by weight of an **ethylene polymer** having a **melt flow rate of 5 or lower**; and*

*(D) **3-20 parts** by weight of a **propylene polymer** having a **melt flow rate of 5-100**, wherein a **molded article** produced from the resin composition has a **flexural strain at break of 3.5% or higher** and a **deflection temperature under load of 180°C or higher**.*

Segal (col. 10, claims 1-3) discloses a polyesters resin composition comprising 25 to 95 percent of polyethylene terephthalate, 0.5 to 30 percent of polyolefin, and 2 to 70 percent of inorganic reinforcement.

The difference between the invention of claims 2, 4 and the disclosure to Segal is that Segal is silent on a composition comprising a propylene polymer having a melt flow rate of 5-100.

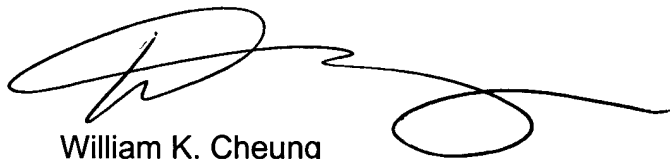
Since Segal (col. 4, line 48) discloses that the polyolefin of Segal's polyester resin composition can be a polypropylene, it would have been obvious to one of ordinary skill in art to incorporate the a polypropylene into the polyester composition of Segal to obtain the invention of claims 2, 4. Although Segal is silent that the propylene polymer having a melt flow rate of 5-10, in view of the broad melt flow rate range of 5-10 being claimed, the examiner has a reasonable basis to believe that the claimed melt flow rate range is inherently possessed by the polypropylene of Segal.

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (703) 305-0392. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5885.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'William K. Cheung', with a large, stylized loop at the end.

William K. Cheung

Patent Examiner

December 21, 2003